

Smith, Clifford L.

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### III. Remarks Concerning the Claim Amendments

Applicant thanks the Examiner for the careful and thorough examination of the present application. Claims 4, 7 and 8 were previously amended in Applicant's first Response to Office Action. Claims 1-16 remain pending in the application.

### IV. Response to Examiner's Section 112 Rejections

Independent Claim 1 is amended to remove the matter considered new by the examiner. The applicant notes that the removed, previously presented range was within the range taught by the specification and was wholly taught by the specification, without being limiting.

### V. Response to Examiner's Section 103 Rejections

To establish a prima facie case of obviousness, [1] there must be some suggestion or motivation to modify the reference or combine the reference teachings; [2] there must be some reasonable expectation of success; and [3] the prior art must teach or suggest all the claim limitations. MPEP § 706.02(j).

Firstly, neither the Watson et al. patent (US 6,073,648) nor the Oshima et al. patent (US 4,889,602) provide some suggestion or motivation to modify the reference or combine the reference teachings. Both references teach the ability to protect against corrosion with an electroplating coating, but only Watson addresses multiple coatings and use of coatings to combat wear. Though the "motivation to combine the references to arrive at the claimed invention can be found in the 'nature of the problem to be solved,'" contrary to *Ruiz v. A.B. Chance Co.*, in the present case only Watson address the problem solved. MPEP §2143.01 (citing *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004)). Further, Watson teaches the necessity of the

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use of a "noble-metal," thereby teaching away from the combination of Watson and Oshima, proposed by the Examiner.

Secondly, the prior art does not provide some reasonable expectation of success. As previously stated, Watson teaches the necessity of the use of a "noble-metal," thereby teaching away from the combination of Watson and Oshima. Additionally, the Watson disclosure teaches reliance on what was referred to as "a ceramic coating" to combat wear, and Oshima doesn't address wear resistance. The current disclosure presents disadvantages and shortcomings to the mere use of such a ceramic coating.

Thirdly, the Applicant submits affidavits attesting to unexpected results and commercial success of the current invention. These pieces of objective evidence "are relevant to the issue of obviousness and must be considered in every case in which they are present." MPEP §2141.

## VI. Conclusion

The cited prior art does not meet any of the requirements to establish a prima facie case for obviousness. The prior art neither suggests nor motivates one to modify the reference or combine the reference teachings to achieve the current invention as claimed in the independent claim. Even if one were to consider making the suggested modification, there is no teaching in the prior art that would provide support for some reasonable expectation of success, but instead Watson teaches away from the combination. Further, objective evidence is presented that demonstrates the non-obviousness of the current invention. Therefore, a finding of obviousness as a basis for rejection of allowance is unfounded.

As amended, Claim 1 should now be suitable for allowance.

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Since all the remaining claims depend from Claim 1, all of the remaining claims should also be suitable for allowance.

The applicants respectfully request reconsideration of the rejection of these claims, and the issuance of a notice of allowance of all pending claims.

Respectfully submitted,

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